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10/586,901	07/21/2006	Denis Fauconnier	MTR.0103US	5373

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1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

CHAKOUR, ISSAM

ART UNIT	PAPER NUMBER
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4163

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,901	Applicant(s) FAUCONNIER ET AL.	
	Examiner ISSAM CHAKOUR	Art Unit 4163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 and 11-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Rasanen (US 2002/0045447)

3. Regarding claims 1 and 25, Rasanen discloses a method of managing communications in a telecommunication system comprising at least one first and one second subsystems, terminals being able to communicate via the second subsystem according to both a first communication mode and a second communication mode, the terminals not being able to communicate via the first subsystem according to both the first communication mode and the second communication mode (See claim 1), the method comprising the following steps, in relation to one of said terminals having a first communication in progress with the first subsystem according to the first communication mode (See figure 1):
detecting a request to set up a second communication according to the second

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communication mode for said terminal, said set-up request being initiated by said terminal to the first subsystem (See paragraph [0066], line 9); in response to the detection of said request, initiating a transfer or handover of the first current communication to the second subsystem (See paragraph [0069], line 7); and setting up a second communication with the second subsystem according to the second communication mode (See paragraph [0069], lines 3-5).

4. Regarding claims 2 and 26 Rasanen teaches the method as claimed in claims 1 and 25 respectively, in which the first subsystem is a second generation radio communication system (e.g. GSM, see paragraph [0070], line 4).

5. Regarding claims 3 and 27, Rasanen discloses the method as claimed in claims 1 and 25 respectively, in which the second subsystem is a third generation radio communication system (e.g. UMTS or GPRS, see paragraph [0070], line 5).

6. Regarding claims 4 and 28, Rasanen further discloses the method as claimed in claims 1 and 25 respectively, in which the first communication mode is a circuit mode (e.g. circuit switched network, see paragraph [0005], lines 3-6).

7. Regarding claims 5 and 29, Rasanen discloses the method as claimed in claims 1 and 25 respectively, in which the second communication mode is a packet mode (e.g. packet switched network, see paragraph [0006], lines 3-4).

8. Regarding claims 6 and 30, Rasanen discloses the method as claimed in claims 5 and 29 respectively, in which the first subsystem is a second generation radio communication system and in which the request to set up a second communication is sent by the terminal via a message (See claim 1) relating to the "Dual Transfer Mode" functionality (A dual mode mobile is equipped with the means for dual transfer mode for the two communication modes, see abstract, line 16).

9. Regarding claims 7 and 31, Rasanen discloses the method as claimed in claims 1 and 25 respectively, in which the detection of the request to set up a second communication results from the initiation of said request by the terminal or the mobile station (See paragraph [0066], lines 8-9).

10. Regarding claims 8 and 32, Rasanen discloses the method as claimed in claims 1 and 25 respectively, in which the detection of the request to set up the second communication is carried out on the first subsystem (See paragraph [0068], lines 7-10).

11. Regarding claims 9 and 33, Rasanen discloses the method as claimed in claims 1 and 25 respectively, in which the transfer of the first current communication to the second subsystem is initiated and implemented by one or other of the terminal or the first subsystem (See paragraph [0047], Line 5-6).

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12. Regarding claim 11, Rasanen further discloses a terminal or mobile station (See abstract) comprising:

means for communicating via a second subsystem of a telecommunication system

according to both a first communication mode and a second communication mode, the

terminal not being able to communicate via a first subsystem of the telecommunication

system according to both the first communication mode and the second communication

mode (See claim 1);

means for initiating and for transmitting to the first subsystem a request to set up a

second communication according to the second communication mode, when it has a

first communication in progress with the first subsystem according to the first

communication mode (See paragraph [0066], line 9 also see paragraph [0017], on page

2, lines 10-14); and

means for continuing the first current communication on the second subsystem (e.g.

means for performing handover, see claim 7) , these means being deployed after the

means for initiating and for transmitting to the first subsystem a request to set up a

second communication according to the second communication mode have been

deployed (See paragraph [0069], line 7).

13. Regarding claim 12, Rasanen teaches the terminal in accordance with claim 11,

in which the first subsystem is a second generation radio communication system (e.g.

GSM, see paragraph [0070], line 4).

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14. Regarding claim 13, Rasanen discloses the terminal as claimed in claim 12, in which the means for initiating and transmitting to the first subsystem a request to set up a second communication according to the second communication mode use a message relating to the "Dual Transfer Mode" functionality (e.g. MS equipped with dual mode transmission capabilities in 2G and 3G communication networks, see paragraph [0035], see also [0039], and claim 8).'

15. Regarding claim 14, Rasanen discloses the terminal as claimed in claim 11, in which the second subsystem is a third generation radio communication system (e.g. UMTS or GPRS, see paragraph [0070], line 5).

16. Regarding claim 15, Rasanen further claims the terminal as claimed in claim 11, in which the first communication mode is a circuit mode (e.g. circuit switched network, see paragraph [0005], lines 3-6).

17. Regarding claim 16, Rasanen teaches the terminal as claimed in claim 11, in which the second communication mode is a packet mode (e.g. packet switched network, see paragraph [0006], lines 3-4).

18. Regarding claim 17, Rasanen teaches the terminal as claimed in claim 11, in which the means for continuing the first current communication on the second subsystem respond to a command from the first subsystem (e.g. request for handover, see paragraph [0060], lines 3-8).

19. Regarding claim 18, Rasanen teaches the terminal as claimed in claim 11, in which the means for continuing the first current communication on the second

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subsystem respond to an initiation and a transmission by the means for initiating and for transmitting a request to set up a second communication according to the second communication mode (See paragraph [0069], lines 4-7).

20. Regarding claim 19, Rasanen teaches an access controller (e.g. BSC, see paragraph [0030], line 1-4, see also claim 6) claim in a first subsystem of a telecommunication system also comprising at least one second subsystem, terminals being able to communicate via the second subsystem according to both a first communication mode and a second communication mode (e.g. BS-A serves the first radio network or subsystem according to 2G and BS-B serves second radio network or subsystem with 3G mode of communication, see figure 1), the terminals not being able to communicate via the first subsystem according to both the first communication mode and the second communication mode (See claim 1), and the access controller comprising, in relation to one of said terminals having a first communication in progress with the first subsystem according to the first communication mode, under the control of said access controller (See figure 1):

means for detecting a request to set up a second communication according to the second communication mode for said terminal, said set-up request being initiated by said terminal to the first subsystem; and

means for, in response to a detection of the request to set up a second communication according to the second communication mode for said terminal, initiating a transfer of the first current communication to the second subsystem (In accordance with the

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method in claim 1 by the applicant, means for performing the steps can be carried out by the access controller, see paragraph [0037].

21. Regarding claim 20, Rasanen teaches the access controller in accordance with claim 19, in which the first subsystem is a second generation radio communication system (e.g. GSM, see paragraph [0070], line 4).

22. With respect to claim 21, Rasanen discloses the access controller as claimed in claim 19, in which the second subsystem is a third generation radio communication system (e.g. UMTS or GPRS, see paragraph [0070], line 5).

23. . Regarding claim 22, Rasanen teaches the access controller according to claim 19, in which the first communication mode is a circuit mode (e.g. circuit switched network, see paragraph [0005], lines 3-6).

24. Regarding claim 23, Rasanen teaches the access controller according to claim 19, in which the second communication mode is a packet mode (e.g. packet switched network, see paragraph [0006], lines 3-4).

25. With respect to claim 24, Rasanen teaches the access controller according to claim 19, in which the means for detecting a request to set up a second communication according to the second Communication mode for said terminal (See paragraph [0050]) comprise the reception of a message relating to the "Dual Transfer Mode" functionality (Note that the dual mode mobile station has the dual transfer mode functionality that it uses to send the request for handover in heterogeneous networks)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Soderbacka et al (US 2003/0114158) discloses a method for handover between mobile network of second and third generation where the mobile terminal is a dual mode mobile terminal. Similarly Singh et al (US 6,963,745) teaches a seamless handover method using a dual mode mobile terminal from a GSM network to a UMTS network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISSAM CHAKOUR whose telephone number is (571)270-5889. The examiner can normally be reached on Monday-Thursday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Robinson can be reached on 5712722319. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IC

/Mark A. Robinson/

Supervisory Patent Examiner, Art Unit 4163